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REMARKS

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 are in the application. Claims 1, 16 and 20 are currently amended; claims 2, 7-9, 11-14, 17, 24 and 25 were previously presented; claims 3-5, 10, and 21-23 are cancelled; and claims 15, 18, and 19 remain unchanged from the original versions thereof. Claims 1, 16, and 20 are the independent claims herein.

No new matter is added to the application as a result of the presently presented Response. Support for the amendments of claims 1, 16, and 20 may be found in the specification at least at paragraphs [0045] – [0047].

Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 USC § 112, 1st Paragraph

Claims 1-2, 6-9, 11-22, and 24-27 were rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Applicant respectfully submits that each of claims 1, 2, 6-9, 11-22, and 24-27 submitted herewith for entry and consideration are in compliance with the enablement requirement per 35 USC 112, 1st paragraph. That is, the claims contain subject matter that is in fact described in the specification in a manner that is clear, concise, and in exact terminology so as to enable one skilled in the art to which the claims pertain.

In particular, the claims have been amended to further clarify the claimed risk assessment factors are selected from the group consisting of a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion.

Applicant respectfully submits that the recited aspects of receiving information relating to a person's status, receiving information relating to a plurality of risk assessment factors, assigning a numerical value to each of the plurality of risk assessment factors, assigning a weight to each of the plurality of risk assessment

factors, calculating the plurality of risk factors and the risk quotient, and providing the suggested action stated in independent claims 1, 16, and 20 are stated in clear, concise, and exact terms. As previously stated, support for the submitted claim amendments may be found in the Specification at least at paragraphs [0045] – [0047] wherein at least one detailed, explicit example is disclosed regarding the risk assessment factors, the numerical values and weights assigned thereto, the calculation of the risk factors and the risk quotient (including exemplary values), and the providing of a suggested action based on the calculated risk quotient.

Applicant emphasizes that the risk assessment factors are assigned numerical values that provide an indication of the "relative" risk of each risk assessment value with respect to the other risk assessment values. Accordingly, as discussed in the Specification, the exact numeric value assigned to a risk assessment factor is not as significant as the relative value of the various risk as assessment factors. The Examiner however appears to request details that are not necessary to the practice and understanding of the claimed invention. The example provided in the Specification is clear, and provides a concrete result (i.e., provide a suggested action).

Applicant respectfully submits that one skilled in the art would be enabled to make or use the invention since those skilled in the art would be knowledgeable of how to assign (i.e., associate) a numeric value to a category of factors and how to assign a weight to a category of factors depending on a relative importance of each factor. Applicant claims and specifies the particular risk assessment factors and how the numeric assignments are to be made (i.e., based on a relative significance of the risk assessment factors).

Furthermore, as with many real-word methodologies that provide concrete results (e.g., ratings, suggestions, rankings, warnings, etc.), not including an explicit recitation of the exact criteria used in the methodology does not invalidate or otherwise make the results any less concrete or the method less enabling. For example, if the criteria used in the claimed method are used consistently, the claimed result will be real and reproducible. Also for example, Applicant notes methods used to generate government

crash test ratings for cars (e.g., 1 – 5 stars) and even movie ratings (e.g., 1 – 4 or 5 stars) provide real results that may be reproduced. The method used to obtain the result here (i.e., a rating based on a number of stars) is also reproducible. The exact numeric star rating may or may not be the same.

Accordingly, it is not seen as necessary for the claims to include a specific range of values for the risk assessment factors and the weights, and a specific recitation of whom assigns the risk assessment values. This is particularly true in light of the Examiner not citing or providing any prior art necessitating greater specificity beyond the workable example included in the Specification and claimed.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 112, 1st paragraph.

Claim Rejections Under 35 USC § 112, 2nd Paragraph

Claims 1-2, 6-9, 11-20, and 24-27 were rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In light of the amendments submitted herewith, Applicant respectfully submits that the rejection under 35 USC 112, 2nd paragraph is overcome (i.e., moot). That is, the claims particularly and distinctly state that which is claimed by Applicant.

Furthermore, it is not seen as necessary for the claims to include a specific range of values for the risk assessment factors and the weights, and a specific recitation of whom assigns the risk assessment values. This is particularly true in light of the Examiner not citing or providing any prior art necessitating greater specificity beyond the workable example included in the Specification and claimed.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 112, 2nd paragraph.

Claim Rejections Under 35 USC § 101

Claims 1-2, 6-9, 11-20, and 24-27 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicant respectfully submits that the rejection under 35 U.S.C. 101 is overcome by the presently presented amended claims. The claimed invention is (1) within the technological arts and (2) the claimed invention produces a useful, concrete, and tangible result (e.g., provide a suggested action associated with the legal action).

In particular, the claimed result is in fact a concrete and tangible result. The claimed result is also reproducible. That is, one practicing the claimed invention would in fact be able to calculate a risk quotient and in response thereto generate a suggested action associated with the legal action, as recited in the claims.

Applicant points out that a particular or exact risk quotient value or a specific suggested action is not claimed by Applicant. Despite this fact, the Examiner appears to suggest that the claims include such specificity. Applicant respectfully submits that one skilled in the art could repeat and implement the claimed invention without undue experimentation to an extent commensurate with the claims and the Specification.

The result of "generating a suggested action associated with the legal action" is reproducible.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 101.

Claim Rejections Under 35 USC § 103(a)

Claims 1-2, 6-9, 11-20, and 24-27 are rejected as being unpatentable over Heckman et al., U.S. Patent No. 5,875,431 (hereinafter, Heckman) in view of Halligan et al., U.S. Publication No. 2002/0077941 (hereinafter, Halligan). This rejection is respectfully traversed.

Regarding claims 1, 16, and 20, Heckman system receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome feedback data from which future litigation/legal templates might be drawn (col. 16 lines 16- 21). Heckman describes how the three kinds of data can be applied to attain the objectives of the Heckman system (monitor legal costs, monitor attainment of objectives and control deliverables derived from completion of tasks).

Applicant respectfully submits that the Heckman does not disclose or suggest, at least, the claimed "assigning a numerical value to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors; calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating a suggested action associated with the legal action".

Regarding the cited and relied upon Halligan, it is noted that Halligan is directed to methods and a system in which selected data and other information about a trade secret is collected and characterized and entered into a specialized database with certain functions. Specifically, Halligan discloses, "[T]rade secret is a recognized intellectual property right under United States laws, and also under the laws of many foreign countries. Trade secrets are a form of intellectual property, just as patents, trademarks, and copyrights are forms of intellectual property. However, the rights protected by each category of intellectual property are not the same as or suggestive of a legal action (e.g., court proceeding or action involving adverse parties). A trade secret is no more a "legal action" than is a patent.

Applicant respectfully submits that Halligan does not disclose or suggest, at least, receiving information relating to a legal action. Halligan discloses a legal reviewer reviewing and adding comments regarding information descriptive of a trade secret

(paragraph [0022]), and legal criteria related to factors or tests applied to ascertain if information pertains to a trade secret as described in the U.S., Section 757 of the First Restatement of Torts. (paragraph [0009]) That is, the information regarding the trade secret is received and reviewed, not a legal action.

Halligan is not concerned with a managing or assessing a risk related to a legal action. Halligan is instead directed to the documentation, analysis, auditing, accounting, protection, registration, and verification of trade secrets.

Moreover, the alleged combination of Hackman and Halligan fails to disclose or suggest, at least, the claimed "assigning a numerical value to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors, wherein the risk assessment factors are selected from a group consisting of: a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion; calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating a suggested action associated with the legal action".

Thus, it is clear that even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the patentable differences between the claims and the combination of Heckman and Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 6-9, 11-15, 17-19, and 24-27 depend from claims 1, 16, and 20. It is further submitted that all of the pending claims 1, 2, 6-9, 11-20, and 24-27 are patentable over Heckman and Halligan under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 103(a).

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CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

July 26, 2006
Date

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